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NIXON PEABODY LLP			EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/594,403

Applicant(s)

CASPERS ET AL.

Examiner

ROSS A. WILLIAMS

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/3/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7-9, 16, 17, 43, 44, 46 and 48-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 7-9, 16, 17, 43, 44, 46, 48-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 60 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The wording of the claim renders the claim incomprehensible.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 8, 9, 16 - 18, 44, 46, 48, 50, 51, 54 – 58, 61 - 63 are rejected under 35 U.S.C. 102(e) as being anticipated by Marks et al (US 7,357,716).

Regarding claim 1, Marks discloses:

an input device configured to receive a wager input from a player for playing a wagering a display device configured to display (Marks 5:35 – 41),

A display device configured to display (Marks 5:35 – 40)

a basic game having a plurality of symbols that indicate a randomly selected outcome of said basic game, said randomly selected outcome being selected in response to the a wager input by the a player; and (Marks 6:30 – 7:23)

a progressive game feature having a progressive award that is triggered by a predetermined event, said progressive award including a plurality of free increasing based on said wager being received at said gaming terminal and other wager inputs being received from other gaming terminals, said progressive award having has an actual value determined by said plurality of free plays of said progressive award (Marks teaches a progressive award feature that is triggered by a multitude of triggering events. The progressive award is a percentage progressive award, wherein the progressive award is based upon a designated percentage of the wager made by the player. Marks teaches that the progressive award can of many different types of awards such as number of credits, amount of products, *number of free spins*, and *for* amount of services. When the award is free spins, the actual value of the progressive award will vary according to the follow up game play and the number of winning combinations the player achieved in with the free spins) (Marks 3:35 – 4:9, 7:54 – 8:50).

Regarding claim 4, wherein said plurality of free plays yields a monetary or non-monetary value associated with randomly selected outcomes of said plurality of free plays (Marks 3:35 – 4:9, 7:54 – 8:50).

Regarding claim 8, wherein said predetermined event is a selection of a progressive-award outcome from a plurality of progressive game outcomes that are randomly selectable in response to receiving said wager input (Marks 8:25 – 32).

Regarding claim 9, wherein said progressive award is measured in integers and increases by an incremental value for each wager input, said incremental value being a fraction of the integers associated with said progressive award. (Marks 8:20 – 32).

Regarding claim 16, wherein said progressive game feature has multiple progressive awards that are determined by said plurality of free plays follow up game play by said player at said gaming terminal (Marks 3:35 – 4:9, 7:54 – 8:50).

Regarding claim 17, wherein said actual value may be zero based on said plurality of free plays follow up game play (the player does not automatically win the free play games).

Regarding claim 18,
accepting, at an input device, a wager input from a player for playing a wagering game; (Marks 5:35 – 41),

conducting a basic game of the wagering game at a plurality of gaming terminals in response to receiving wager inputs; (Marks 6:30 – 7:23)

displaying the basic game on respective display devices of the plurality of gaming terminals; (Marks 5:35 – 40)

changing said progressive award in response to said wager inputs received at said plurality of gaming terminals, said progressive award including a plurality of free

plays increasing based on said wager inputs received at said plurality of gaming terminals; and

in response to a randomly selected outcome being a progressive-award outcome, awarding said progressive award to a player, said progressive award having an actual value determined by said player conducting said plurality of free plays at a respective one of said gaming terminals. *(Marks teach a progressive award feature that is triggered by a multitude of triggering events. The progressive award is a percentage progressive award, wherein the progressive award is based upon a designated percentage of the wager made by the player. Marks teaches that the progressive award can of many different types of awards such as number of credits, amount of products, number of free spins, and /or amount of services. When the award is free spins, the actual value of the progressive award will vary according to the follow up game play and the number of winning combinations the player achieved in with the free spins) (Marks 3:35 – 4:9, 7:54 – 8:50).*

Regarding claim 44, allowing said player to engage in said plurality of free plays follow up game play (Marks 3:35 – 4:9).

Regarding claim 46, further comprising the step of awarding to said player said actual value in response to outcomes achieved in said plurality of free plays follow up game play (the free plays of Marks have actual award value)

Regarding claim 48, wherein said randomly selected outcome is an outcome that is not selected during said basic game (when the player plays the free plays the

outcomes selected for the free plays are not selected in the base game, the player is only playing the free plays and not the base game at any one time.)

Regarding claim 50, wherein said randomly selected outcome is determined after a preselected wager amount is received at one of said plurality of gaming terminals. (Marks 7:54 – 8:50).

Regarding claim 51, wherein said preselected wager amount is the maximum wager amount at said plurality of gaming terminals. (marks 8:25 – 33).

Regarding claim 54, Marks discloses:
using an input device to accept a wager input for providing wagering game play; (Marks 5:35 – 41),

displaying the wagering game play on a display device of a gaming terminal; (Marks 5:35 – 40)

in response to the wagering game play being displayed at one or more gaming terminals linked to a progressive award, using a progressive game controller to increase the progressive award by incrementing the number of free plays; and

in response to a triggering event resulting from the wagering game play, awarding the current number of free plays associated with the progressive award. . (Marks teaches a progressive award feature that is triggered by a multitude of triggering events. The progressive award is a percentage progressive award, wherein the progressive award is based upon a designated percentage of the wager made by the player. Marks teaches that the progressive award can of many different types of awards such as number of credits, amount of products, number of free spins, and /or amount of services.

When the award is free spins, the actual value of the progressive award will vary according to the follow up game play and the number of winning combinations the player achieved in with the free spins) (Marks 3:35 – 4:9, 7:54 – 8:50).

Regarding claim 55, conducting the current number of free plays to determine an actual monetary value of the progressive award. (Marks 3:35 – 4:9, 7:54 – 8:50).

Regarding claim 56, wherein the actual monetary value is based on the payoff amount associated with the randomly selected outcome of each free play. (Marks 3:35 – 4:9, 7:54 – 8:50).

Regarding claim 57, wherein the one or more gaming terminals includes a plurality of gaming terminals (Marks 5:31 – 34).

Regarding claim 58, wherein the wagering game play includes wager inputs such that the increasing includes increasing the progressive award in response to the wager inputs (Marks 6:1 – 9).

Regarding claim 61, including displaying the progressive award on the one or more gaming terminals (Marks Fig 1a).

Regarding claim 62, further including displaying the progressive award on signage distinct from the one or more gaming terminals. (Marks Fig 1a).

Regarding claim 63, displaying a representation of a fraction of a free play between the current number of free plays and a next higher whole number of free plays. (Marks Fig 1a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al (US 7,357,716) in view of Vancura (US 2004/0053666).

Regarding claim 7, Marks fails to disclose " wherein said progressive award is associated with a multiplier value, said multiplier value increasing increases the value of a monetary award achieved in said plurality of free plays follow up game play." However, Vancura teaches a game machine that offers a player a free play mode, wherein the free play mode award is based upon a multplier (Vancura 0041).

It would be obvious to one of ordinary skill in the art to modify Marks in view of Vancura to provide a progressive award that offers a player a free play mode wherein the award the player achieved during the free play mode is increased by a multiplier.

This would enable the player to increase the potential award that the y are able to recieve during the game.

Claim 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al (US 7,357,716) in view of Luciano (6,887,154)

Regarding claim 49, Marks fails to teach "wherein said randomly selected outcome is determined by a progressive-game controller that is external to said plurality of gaming terminals". However Luciano discloses a progressive controller that is external to the game machine that determines the random combinations selected (Luciano 1:12 – 32). It would be obvious to one of ordinary skill in the art to modify Marks in view of Vancura to provide a progressive controller to determine the random selected outcome. This would eliminate some of the processing load from the main game machine.

Claim 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al (US 7,357,716) in view of Huard (6,929,264)

Regarding claim 52 and 53, Marks does not disclose, in response to said wager input being more than said preselected wager amount and said progressive award being awarded, using a remainder of said wager input to determine if a consolation prize is won by said player, the remainder of said wager input being the difference between said wager input and said preselected wager amount. However Huard discloses a game wherein the player makes a secondary wager on top of the primary wager to be eligible for a consolation prize in the event the the player does not win the

primary outcome (Huard 19:15 – 20). This auxiliary wager can be views as the remainder of an initial wager. It would be obvious to one of ordinary skill in the art to modify Marks in view of Huard to provide a game wherein the player receives a consolation prize for making betting extra money or credits. This ensures that player wins some sort of award.

Claim 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al (US 7,357,716)

Regarding claim 59, Marks does not disclose specifically “resetting the number of free plays to a startup value after the awarding of the current number of free plays.” (This would be obvious in view of the fact that if the game machine did not reset to a predefined number the free play mode would continue indefinitely and the game establishment would lose money.)

Response to Arguments

Applicant's arguments with respect to claims 1, 4, 7-9, 16, 17, 43-44, 46, 48-63 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROSS A. WILLIAMS whose telephone number is 571-272-5911. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ronald Laneau can be reached on 571-272-6784. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. W./
Examiner, Art Unit 3714

/Ronald Laneau/
Primary Examiner, Art Unit 3714
09/11/09